

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 37

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte JERRY W. SMITH,  
NADINE M. SULLIVAN, and  
RUTH F. EDEN

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Appeal No. 1996-0288  
Application No. 07/873,634

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ON BRIEF<sup>1</sup>

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Before WILLIAM F. SMITH, MILLS, and GRIMES, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from an examiner's final rejection of claims 11 through 13, 27, 29 through 34, 37 through 40, 46, and 47. Claims 14 through 23 are pending but have been withdrawn from consideration by the examiner. As set forth at page 1 of the Appeal Brief, claims 31, 37, 40, 46, and 47 are canceled. Thus, claims 11 through 13, 27, 29, 30, 32 through 34, 38, and 39 are before us for review.

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<sup>1</sup> Appellants requested an oral hearing in this appeal. However, for reasons which will become apparent, the merits panel has decided that a hearing is not needed. See 37 CFR § 1.94(c).

Claim 27 is representative of the subject matter on appeal and reads as follows:

27. A culture media system comprising: at least one culture media container, containing a material consisting essentially of non-prereduced culture media, said culture media being subject to degradation by exposure to oxygen, moisture loss and syneresis; a package made of material at least substantially impermeable to oxygen and moisture enclosing said container; means for sealing said package; and an active oxygen absorber sealed within said package for actively scavenging oxygen that permeates through said package and residual oxygen contained in said media, to prevent degradation of said media such that said media has an extended shelf life.

The references relied upon by the examiner are<sup>2</sup>:

Cox	4,262,091	Apr. 14, 1981
Kasugai	4,605,617	Aug. 12, 1986

Claims 27, 29, 30, 11 through 13, 32 through 34, 38, and 39 stand rejected under 35 U.S.C. § 103. Claims 27, 29, 30, 11 through 13, 32 through 34, 38, and 39 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. As evidence of obviousness, the examiner relies upon Cox and Kasugai. We reverse.

### Discussion

#### 1. Claim construction.

There is one phrase in claim 27 which needs to be construed before determining the patentability of the claims on appeal, i.e., "non-prereduced culture media." This phrase does not appear to have been part of the original disclosure of this application. Rather, it was added to claim 27 for the first time in the amendment filed July 29, 1993

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<sup>2</sup> The examiner also cites two other references in the Examiner's Answer in responding to appellants' arguments on appeal. See page 6 of the Examiner's Answer. The references are identified as Nakamura and Garner. However, the examiner did not apply the teachings of these references in rejecting the claims on appeal. As stated in *In re Hoch*, 428 F.2d 1341, 1342 n. 3, 166 USPQ 406, 407 n. 3 (CCPA 1970), "[w]here a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of the rejection." Accordingly, we have not considered Nakamura and Garner in deciding the issues raised in this appeal.

(Paper No. 19). In arguing their position in this appeal at pages 4-5 of the Appeal Brief, appellants assert that "non-prereduced" is "a term well known in the art of sterile culture media systems" and that the term is defined on page 5 [sic, 6], lines 12-16 of the specification. That passage of the specification states:

In the method of making a package system to provide stability and increased shelf life, the culture dishes may be filled with medium in an aerobic atmosphere, that is, without the necessity for providing an anaerobic atmosphere.

In other words, the term "non-prereduced" means that the culture media container of the claimed culture media system contains a culture media that was formed in an aerobic atmosphere, not an anaerobic atmosphere.

2. Claim definiteness.

The examiner states at page 3 of the Examiner's Answer that the phrase "non-prereduced" is "unclear in that it is unclear how, in this instance, the method of making limits the structure and it is unclear what redox condition of the medium is intended." As set forth above, the specification makes clear that the culture media which is part of the claimed culture media system was provided to the culture media container in an aerobic, rather than anaerobic atmosphere. With this distinction in mind, one of ordinary skill in the art would be able to discern the difference between a culture media container filled with culture media under aerobic conditions and a culture media container filled with culture media under anaerobic conditions. In other words, a culture media system which in other respects meets the requirements of claim 27 on appeal but contains a culture media container filled with culture media under anaerobic conditions would not meet the requirements of claim 27.

The examiner's rejection under 35 U.S.C. § 112, second paragraph, is reversed.

3. Obviousness.

As we understand the examiner's position, it is that Cox describes a culture media system as required by claim 27 with the exception of the claim requirement of an active oxygen absorber sealed within the package for actively scavenging oxygen. The examiner relies upon Kasugai for its disclosure of an active oxygen absorber sealed within a culture media system. The examiner believes that it would have been obvious to one of ordinary skill in the art to use an active oxygen absorber within the culture media system of Cox "in order to maintain the anaerobicity of the package, i.e., to scavenge any residual, generated or leaked oxygen or in order to generate the anaerobic atmosphere of Cox." Examiner's Answer, page 4. We disagree.

As seen from Figure 1 of Cox and the accompanying description of the figure in the specification, the culture media system of that reference is prepared under anaerobic conditions. The culture media supplied to the culture media system of Cox is also prepared under anaerobic conditions. See, e.g., column 5, lines 14-38. The first reason given by the examiner for providing an active oxygen absorber in the sealed package of Cox lacks factual support on this record. The examiner asserts that it would have been obvious to provide an active oxygen absorber to "scavenge any residual, generated or leaked oxygen" in the sealed package of Cox. However, the examiner has not established in the first instance that the sealed package of Cox would expectedly contain any "residual, generated or leaked oxygen." Without factual support for the examiner's predicate in this aspect of the rejection, we hold that the examiner's rejection is not supported by substantial evidence.

The need for the USPTO to explicitly make of record the factual underpinnings for a conclusion of obviousness was recently addressed by our appellate reviewing court. As explained in In re Lee, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002):

With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different devices for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. (BNA) 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

The court went on to state:

The determination of patentability on the ground of unobviousness is ultimately one of judgment. In furtherance of the judgmental process, the patent examination procedure serves both to find, and to place on the official record, that which has been considered with respect to patentability. The patent examiner and the Board are deemed to have experience in the field of the invention; however, this experience, insofar as applied to the determination of patentability, must be applied from the viewpoint of "the person having ordinary skill in the art to which said subject matter pertains," the words of section 103. In finding the relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from this viewpoint. Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The board cannot rely on conclusory statements

when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

In re Lee, 277 F.3d at 1345, 61 USPQ2d at 1435.

Here, the examiner has not adequately explained that the problem which forms the basis for his first proposed reason for combining the references would have been present and so recognized by a person of ordinary skill in the art. A fact-based explanation is needed as to why the Cox product produced under anaerobic conditions would expectedly contain so much oxygen that an active oxygen absorber would be needed. We do not find that the examiner has properly established a prima facie case of obviousness.

The examiner's second alternative reason for combining the teachings of Cox and Kasugai also lacks factual support in the record. The examiner asserts it would have been obvious to place an oxygen absorber in the culture media system of Cox "in order to generate the anaerobic atmosphere of Cox." If the examiner's assertion is viewed in the context of the combined disclosures of Cox and Kasugai without resort to appellants' description of the present invention, it is not apparent on what basis one of ordinary skill in the art would have found it obvious to replace the glove box system of Cox with the package of active oxygen absorber of Kasugai. Absent a fact-based explanation of the examiner's reasoning in support of this proposed substitution, we do not find that the examiner has properly established a prima facie case of obviousness.

Having found the examiner has not established a prima facie case of obviousness, we need not consider appellants' evidence of nonobviousness.

The decision of the examiner is reversed.

REVERSED

William F. Smith	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
Demetra J. Mills	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
Eric Grimes	)	
Administrative Patent Judge	)	

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